

ESTTA Tracking number: **ESTTA474063**

Filing date: **05/23/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91203410
Party	Defendant East West Bank
Correspondence Address	THOMAS T. CHAN FOX ROTHSCHILD LLP PO BOX 79159 LOS ANGELES, CA 90079-0159 UNITED STATES tchan@foxrothschild.com, ipdocket@foxrothschild.com, cliu@foxrothschild.com
Submission	Reply in Support of Motion
Filer's Name	Lisa A. Karczewski, Cindy Liu
Filer's e-mail	ipdocket@foxrothschild.com, cliu@foxrothschild.com
Signature	/Lisa A. Karczewski/, /Cindy Liu/
Date	05/23/2012
Attachments	intC8.PDF ( 5 pages )(31741 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Serial No. 85319594  
For the mark “EAST WEST BRIDGE FORUM”

In the Matter of Trademark Registration No. 3,448,481  
For the mark EAST-WEST BUSINESS BRIDGE  
Date Registered: June 17, 2008

EAST WEST BANK	)	
	)	
	)	
Petitioner,	)	Opposition No. 91203410
	)	
v.	)	[ <i>Consolidated with</i> ]
	)	
THE PLUBELL FIRM, LLC	)	Cancellation No. 92053712
	)	
Respondent.	)	
	)	

**PETITIONER EAST WEST BANK’S REPLY MEMORANDUM IN SUPPORT  
OF MOTION FOR SANCTIONS PURSUANT TO 37 CFR § 2.120(g)**

Mindful of the Board’s Order dated May 7, 2012 regarding the conduct of attorneys in these proceedings, East West Bank (“EWB”) files this short reply memorandum to respond to the improper request made by The Plubell Firm, LLC (“Plubell”) in its opposition, that the TTAB vacate a portion of its May 9, 2011 Order, as well as to very briefly address certain other points made by Plubell.

EWB filed its motion for sanctions for the purpose of seeking the relief explicitly requested, but also to deter future instances of Plubell’s misconduct in the cancellation proceeding. The Board’s May 7, 2012 Order partially alleviates this latter concern, ruling that Plubell was not justified in seeking the depositions of EWB’s chairman and CEO and controller.

EWB trusts that Plubell will abide by the Board's rulings limiting the discovery to which Plubell is allowed in the remainder of these consolidated proceedings.<sup>1</sup>

With respect to the other two bases underlying EWB's motion, sanctions or reprimands to Plubell and its counsel would be well deserved, particularly in light of Plubell's unapologetic arguments it makes in opposition.

Plubell's response to EWB's arguments regarding Ms. Plubell's letters to EWB's executives is to improperly ask the Board to "vacate" the language from its May 9, 2011 Discovery Conference Order that Ms. Plubell ignored. First, the Board cannot and should not grant any request for relief raised in an opposition brief as procedurally improper, and courts should deny or ignore any such requests. See, e.g., Crawford v. County of Dauphin, 2006 WL 218208 (M.D. Pa. 2006) ("It would be inappropriate and unfair to plaintiff to grant relief requested only in a responsive brief."); Jack Tyler Eng. Co., Inc. v. Colfax Corp., 2011 WL 1256610 (W.D. Tenn. 2011) ("In its brief in opposition . . . Plaintiff made in passing two conditional requests for relief. . . . If Plaintiff elects to pursue the relief mentioned, the Court instructs Plaintiff to file separate motions, stating with particularity the grounds for relief requested."). The Board should reject Plubell's request to vacate part of its May 9, 2011 Order.<sup>2</sup>

Second, even if this request was procedurally permissible (which it is not), the only purpose of vacating this language would be to allow Ms. Plubell to continue making thinly veiled threats to EWB's executives and lobbying more disparaging comments<sup>3</sup> about EWB's outside counsel in that same direction. The very fact that Plubell makes this "vacating" request reveals

---

<sup>1</sup> Of course, if Plubell ignores the May 7, 2012 Discovery Order, EWB will seek leave from the Board to bring another sanctions motion.

<sup>2</sup> This should not be interpreted as an acknowledgement that such a motion, if brought by Plubell, would be meritorious. Plubell appears to be asking the Board to reconsider its Order, well beyond the one month period permitted by the TTAB for such motions.

<sup>3</sup> For example, Plubell's letter characterized EWB's outside counsel as taking an independent, and counterproductive course which may well be contrary to the interests of East West Bank." Declaration of Thomas T. Chan filed in support of Motion for Sanctions, Exh. A.

its intention to repeat its misconduct, and demonstrates that Plubell's transgressions were willful and not inadvertent. Moreover, the proper time for asking the Board to reconsider its Order is (i) within the TTAB's allowable one month from the date of the Order for filing a motion for reconsideration (see 37 CFR §2.127(b), TTAB Manual of Procedure §518 (3d ed. 2011)); and (ii) *before doing something the Board has ordered the parties not to do*. For its part, if EWB were to want to communicate directly with Plubell, it would first seek leave from the Board to do so, and any reasonable litigant would do the same after the Board's May 9, 2011 Order. A sanction or reprimand would ensure that Plubell's improper communications come to a halt, and would make Plubell more mindful of the Board's Orders in these proceedings. It would also serve to show future litigants that they ignore the Orders of the TTAB—even the parts in the footnotes—at their peril.

Plubell's opposition is equally unapologetic with respect to its line of deposition questioning to EWB about privacy laws and how EWB responds to requests for information from the federal government regarding "national security" and "fraudulent transactions." Plubell's explanation—that it was merely trying to show that the banking industry is different from the consulting industry because the former is highly regulated and the latter is not—is simply not credible, and does not pass the "smell" test. Plubell's questions were not about the extent of regulation in the banking and consulting industries; they pertained to certain specific areas of regulation. EWB does not know what motivated Plubell to try to get EWB to testify about consumer privacy laws, or about how it responds to certain types of information requests from the federal government. Based on the questions asked, EWB can only conclude that Plubell has some baseless legal theory that in responding to federal information requests, it thinks that EWB may have violated consumer privacy laws. Obviously this has less than nothing to do with the parties' trademarks, or anything else at issue in these proceedings. Plubell has

been caught trying to use this proceeding to fish for discovery to support a potential civil action against EWB. This abuse of the discovery process is deserving of sanctions.

Even if Plubell's explanation were true, Plubell was still in breach of the Board's Orders by taking more discovery than necessary. Plubell could show that banks are subject to more regulation than consulting firms by introducing into evidence the regulations themselves, or asking the Board to take judicial notice of them. EWB's practices in responding to national security information requests do not help Plubell establish this point, thus even if the Board gives credence to Plubell's ex post explanation, its counsel asked these questions in disregard of the Board's Order to take no more discovery than necessary.

For the foregoing reasons, EWB respectfully requests that the Board grant EWB's Motion for Sanctions and award EWB the relief sought therein.

Respectfully submitted,

Dated: May 23, 2012

By: /Aaron Craig/  
Thomas T. Chan  
Aaron Craig  
Lisa A. Karczewski  
Attorneys for PETITIONER  
EAST WEST BANK

Fox Rothschild LLP  
1055 W. 7th Street, Suite 1880  
Los Angeles, CA 90017  
Telephone: (213) 624-6560  
Facsimile: (213) 622-1154  
Email Addresses:  
[cliu@foxrothschild.com](mailto:cliu@foxrothschild.com)  
[IPDocket@foxrothschild.com](mailto:IPDocket@foxrothschild.com)

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **PETITIONER EAST WEST BANK'S REPLY MEMORANDUM IN SUPPORT OF MOTION FOR SANCTIONS PURSUANT TO 37 CFR § 2.120(g)** has been served on Respondent's attorneys of record by electronic mail on this May 23, 2012, addressed as follows:

H. David Starr  
THE NATH LAW GROUP  
112 South West Street  
Alexandria, VA 22314  
E-Mail: [dstarr@nathlaw.com](mailto:dstarr@nathlaw.com)

David N. Makous  
Mina I. Hamilton  
LEWIS BRISBOIS BISGAARD & SMITH LLP  
221 N. Figueroa Street, Suite 1200  
Los Angeles, CA 90012  
E-Mails: [Makous@lbbslaw.com](mailto:Makous@lbbslaw.com)  
[Hamilton@lbbslaw.com](mailto:Hamilton@lbbslaw.com)

/Cindy Liu/  
Cindy Liu  
Dated: May 23, 2012